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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/380,222	08/26/99	WILHOIT	D 2393/501

IM71/0927

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EXAMINER

NAKARANI, D

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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AS

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09/380,222 08/26/99 WILHOIT

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EXAMINER

000757 IM52/0606
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NAKARANI, D
ART UNIT PAPER NUMBER

1773
DATE MAILED:

06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/380,222	Applicant(s) Wilhoit et al	
	Examiner D. S. Nakarani	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Aug 26, 1999

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-45 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-45 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 & 4 20) Other: _____

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DETAILED ACTION

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 13, 14 and 34 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2 and 17 of prior U.S. Patent No. 5,928,740. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

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4. Claims 1-12, 15-33, 35, 36 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,928,740. Although the conflicting claims are not identical, they are not patentably distinct from each other because a thermoplastic polymer having melting point between 115 to 130⁰C of the present invention includes an unmodified thermoplastic polymer having melting point between 115 to 130⁰C of U.S. Patent 5,928,740. Furthermore other limitations which are not specifically claimed in the U.S. Patent 5,928,740 would have been obvious to a person of ordinary skill in the art at the time this invention made to optimize composition and/or laminating additional layers for desired properties and/or application.

5. Claims 37-44 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U. S. Patent No. 5,928,740 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The process of making laminate of U.S. Patent 5,928,740 is fully disclosed and is identical to the process claimed in the instant invention

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application

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which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP. § 804.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

7. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Idlas (U.S. Patent 5,759,648).

Idlas teaches a multi layer film having a second or fourth layer which comprises (1) a copolymer of ethylene and at least one C₄-C₈ α-olefin; (2) a second ethylene copolymer of ethylene and vinyl ester or alkyl acrylate, an acid modified copolymer of ethylene with at least one -olefin a vinyl ester or an alkyl acrylate; and optional ethylene copolymer and at least one C₃-C₈ α -olefin. (Abstract). The first copolymer of the Idlas' blend has similar properties as the second copolymer of the present invention and at least one melting point of at least 90°C (Col. 12, lines 37-42). The second polymer of the Idlas' blend has similar properties as the optional forth copolymer of the present invention and a melting point of 97°C (Col. 20, lines 51-56). The third copolymer of the Idlas' blend has similar properties to the third copolymer of the present

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invention and a melting point of 125⁰C. (See table 1, adhesive plexar 380, and col. 20, lines 34-41). The fourth copolymer of the Idlas' blend has similar properties to the first copolymer of the present invention and has a melting point of less than 85⁰C (Col. 13, lines 25-27).

The film is taught to be irradiatively cross linked (col. 16, lines 25-27) and is fabricated into bags. (Col. 7, lines 22-23). The multi layer film has an EVOH core barrier layer which controls oxygen permeability to less than about 15 cm³/m². (Col. 11, lines 14-20). It is preferably biaxially stretched (col. 14 lines 58-59) and is heat shrinkable at 90⁰C. (Col. 15, lines 5-17). The film is made by coextrusion or lamination (col. 14, lines 40-44) and has an innermost heat sealing layer. (Col. 10, lines 5-9).

Idlas also teaches at least three layers comprising a layer of the blended copolymer (layer 2), a layer comprising at least 50% of an ethylene copolymer with at least one α -olefin (layer 5), and a core EVOH layer between both of the aforementioned layers. (Abstract). Layers 4 and 5 of Idlas also meet the claimed embodiment of claim 25.

9. Receipt of Information Disclosure Statements filed August 26, 1999 and December 3, 1999 is acknowledged and have been made of record.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D.S. Nakarani whose telephone number is (703) 308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

DNakarani:evh

05/31/01


D. S. NAKARANI
PRIMARY EXAMINER